

DOCKET NO.: MSFT-0103/127334.6
Application No.: 09/482,843
Office Action Dated: August 12, 2003

PATENT
REPLY FILED UNDER EXPEDITED
PROCEDURE PURSUANT TO
37 CFR § 1.116

REMARKS/ARGUMENTS

The foregoing Amendment and the following Remarks are submitted in response to the FINAL Office Action issued on August 12, 2003 (Paper No. 7) in connection with the above-identified patent application, and is being filed within the three-month shortened statutory period set for a response by the Office Action.

Claims 121, 124, and 126-135 are pending in the present application, and stand finally rejected. Claims 106-115 have been canceled, and claim 121 has been amended to include the subject matter of now-canceled claims 122, 123, and 125. Also, claims 124, 126, and 128 have been amended to adjust dependencies. Applicants respectfully submit that no new matter has been added to the application by the Amendment.

Request For Withdrawal of Finality of Office Action

Preliminarily, Applicants respectfully request that the Examiner withdraw the finality of the present Office Action for the reason that the Examiner has set forth a new grounds of rejection that is not necessitated by Applicants' amendment of the claims and that is not based on any IDS filed during the period set forth in Rule 1.97(c). See MPEP 706.07(a).

In particular, it is seen that in the first Office Action mailed on February 19, 2003 (Paper No. 5) in connection with the above-identified application, the Examiner rejected the claims under 35 USC § 103(a) as being obvious over Stefik (U.S. Patent No. 5,715,403) in view of Krishnan (U.S. Patent No. 6,073,124). In response, Applicant filed a Request for Reconsideration on May 19, 2003, where the Request merely argues against the rejection of the claims and did not amend same. No IDS has been filed in connection with the present application except for an IDS filed on February 23, 2000.

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Thereafter, in the present FINAL Office Action, the Examiner has at pages 11 and 12 now rejected the claims under 35 USC § 103(a) as being obvious over Stefik (U.S. Patent No 5,715,403) in view of Krishnan (U.S. Patent No. 6,073,124) AND in view of Rabne (U.S. Patent No. 6,006,332) and further in view of Shear (U.S. Patent No. 6,112,181) and further in view of 'the Official Notice'. Thus, Applicants respectfully submit that the § 103(a) rejection in the present FINAL Office Action is a new grounds of rejection as compared to the § 103(a) rejection in the first Office Action, inasmuch as such rejection in the present FINAL Office Action is based on two additional references and 'the Official Notice' as compared with such rejection in the first Office Action.

Accordingly, and again, based on such new grounds of rejection, the present Office Action should not have been made final. As a result, and also again, Applicants respectfully request that the Examiner withdraw the finality of the present Office Action.

Response to Office Action

The Examiner has rejected claim 121 under 35 USC § 112, second paragraph. Applicants respectfully traverse the § 112 rejection.

The Examiner takes issue with the phrase "the package being separate and apart from the license" in claim 121. Accordingly, Applicants have amended claim 121 to remove such language.

The Examiner also takes issue with "a content/package ID" and with "identifying one of the digital content and the package" as being unclear. Accordingly, and as the Examiner has suggested "a content/package ID" has been replaced with - - a content or a package ID --.

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Finally, the Examiner expresses ambiguity regarding whether the license referenced in claim 121. Applicants respectfully submit that claim 121 as amended only inferentially recites and does not positively recite a license as part of the data structure on the computer-readable medium.

Accordingly, and for all of the aforementioned reasons, Applicants respectfully submit that claim 121 satisfies section 112. Thus, Applicants respectfully request reconsideration and withdrawal of the § 112 rejection.

As was set forth above, the Examiner has newly rejected the claims under 35 USC § 103(a) as being obvious over Stefik (U.S. Patent No. 5,715,403) in view of Krishnan (U.S. Patent No. 6,073,124) AND in view of Rabne (U.S. Patent No. 6,006,332) and further in view of Shear (U.S. Patent No. 6,112,181) and further in view of 'the Official Notice'.

Applicants respectfully traverse the § 103(a) rejection.

Applicants note that the although the present section 103 rejection is set forth at pages 11 and 12 as being based on Stefik, Krishnan,, Rabne, Shear, and 'the Official Notice', the details of the rejection with regard to particular claims at pages 12-22 discuss only the Stefik and Krishnan references. That is, the rejection as set forth by the Examiner with regard to the claims does not at all discuss the Rabne and Shear references or any specific taking of Official Notice, and in particular does not at all discuss how such Rabne and Shear references and 'the Official Notice' could or should be combined with other references to make the claims obvious.

Although the Rabne and Shear references are mentioned at the bottom of page 22, such mention is only in connection with a blanket statement that cannot be said to specifically

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discuss how either of such references is applicable to any claim in particular. Accordingly, Applicants respectfully submit that the Examiner in making the section 103 rejection has not specifically applied the Rabne and Shear references and 'the Official Notice' to the claims, and the Applicants therefore conclude that they are not required to address such Rabne and Shear references and 'the Official Notice' in responding to such section 103 rejection.

Applicants also note that the aforementioned blanket statement at the bottom of page 22 of the present Office Action ambiguously states to the effect that all claimed features contain capabilities of computer systems, and then seems to imply that merely being capable of being instantiated on a computer system makes the claims obvious. Applicants respectfully disagree, and respectfully submit that such blanket statements cannot satisfy the requirement that the Examiner make a prima facie case of obviousness under Section 103(a). In particular, Applicants respectfully point out that such blanket statements amount to a blanket rejection of the claims without providing any specific details. Moreover, such blanket statements do not at all provide any indication of why the cited references should or could be combined to produce the invention recited in the claims.

At any rate, Applicants respectfully submit that independent claim 121 as currently amended to include the subject matter of now-canceled claims 122, 123, and 124 recites a computer-readable medium having stored thereon a data structure corresponding to a digital content package. In particular, the data structure includes fields representing:

- encrypted digital content to be rendered in accordance with a corresponding digital license, where the encrypted digital content is decrypt-able according to a decryption key (KD) obtained from the license;
- a content or a package ID identifying one of the digital content and the package; and

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- license acquisition information including a location of a license provider for providing the license.

Significantly, the license acquisition information is in an unencrypted form, the license provider location is a network address, and the data structure is provided by a content provider having a public key and a private key, where the data structure further includes a field containing the content provider public key.

Again, the Stefik reference discloses a system for controlling use and distribution of digital works. The system is exemplified by multiple repositories wherein the digital works are stored and accessed from such repositories, and are transferred only between such repositories. Each repository is a trusted system and can operate in a requestor mode for requesting a digital work from another repository and a server mode for responding to a request from another repository. Importantly, and as disclosed beginning at column 9, line 20, usage rights (i.e., a license with license terms) are attached to digital works in the Stefik system, and both the work and its attached license are transmitted from a serving repository (at a content provider, e.g.) to a requesting repository (at a client, e.g.). See also Fig. 1 and column 7, lines 16-48. Accordingly, the Stefik reference does not disclose or suggest a package with encrypted digital content, where the package is separate and apart from a corresponding license, and the Stefik package therefore would not include license acquisition information for acquiring a license, as is required by claim 121, inasmuch as the license is already attached to the Stefik package and thus need not be acquired.

Consequently, the Stefik reference also would not disclose whether any such license acquisition information is in an unencrypted form, or that the package have a license provider location set forth as a network address, as is also required by claim 121. Finally, the Stefik

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reference is entirely silent as to the package thereof including a content provider public key, as is further required by claim 121.

The Krishnan reference discloses a system for facilitating digital commerce wherein a client obtains content from a content server and then obtains an electronic license certificate (ELC) or license from a licensing broker / server. However, and significantly, the Krishnan reference does not at all disclose or suggest that the content be in a package with a content/package ID identifying one of the content and the package, as is required by claim 121. Also, and as with the Stefik reference, the Krishnan reference does not disclose whether any license acquisition information is in an unencrypted form, or that the Krishnan package have a license provider location set forth as a network address, as is also required by claim 121. Also, the Krishnan reference is entirely silent as to the package thereof including a content provider public key, as is further required by claim 121.

Thus, Applicants respectfully submit that the combination of the Stefik and Krishnan references does not make obvious independent claim 121 or any claims depending therefrom. Instead, Applicants respectfully submit that such claims are not in fact obvious in view of the cited references, and accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection.

In view of the foregoing discussion, Applicants respectfully submit that the present application, including claims 121-135 is in condition for allowance, and such action is respectfully requested.

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